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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,081	10/14/2003	Martin R. Hodge	004974.01148	5030

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EXAMINER	
HUTSON, RICHARD G	

ART UNIT	PAPER NUMBER
1652	

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04/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/685,081	HODGE, MARTIN R.	
	Examiner	Art Unit	
	Richard G. Hutson	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19,21-27 and 29-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *5,10* is/are allowed.

6)☒ Claim(s) *1-4,6-9,11-19,21-27 and 29-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment of claims 1, 2, 3, 5, 7, 9, 10 and 13-19, in the paper of 1/14/2008, is acknowledged. Claims 1-19, 21-27 and 29-35 are at issue and are present for examination.

Applicants' arguments filed on 1/14/2008, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6-9, 11-19, 21-27 and 29-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyers et al. (U.S. Patent No. 6,656,698 B1).

This rejection was stated in the previous office action as it applied to previous claims -4, 6-9, 11-19, 21-27 and 29-35. In response to this rejection applicants have amended claims 1, 2, 3, 5, 7, 9, 10 and 13-19 and traverse the rejection as it applies to the newly amended claims.

Applicants traverse the rejection on the basis that anticipation under 35 U.S.C. § 102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." VerdegaalBros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that the Office Action acknowledges that Meyers does not disclose a protein comprising SEQ ID NO:2, but states that the basis for the rejection is that "the measurement of kinase activity in human lung cells anticipates the claimed methods on the basis that the 14189 polypeptide of the instant claims is inherently in the human lung cells assayed by Meyers ...."

Applicants submit that Meyers does not anticipate any of claims 1-4, 6-9, 11-19, 21-27, and 29-35 as independent claim 1, as amended recites a purified 14189 polypeptide, which Meyers does not disclose. Applicants further submit that independent claims 7 and 9 as amended recite contacting "a cell-free assay mixture comprising a 14189 polypeptide ....", as Meyers does not disclose contacting a cell-free assay mixture with a 14189 polypeptide.

Applicants complete argument is acknowledged and has been carefully

considered, however, is not found persuasive on for the reasons previously of record and repeated herein. With respect to applicants primary argument that Meyers et al. does not teach a purified 14189 polypeptide, applicants are reminded that applicants claims do not recite a "purified polypeptide" but rather an "isolated polypeptide".

That being said, the methods taught by Meyers et al., that is the measurement of kinase activity in human lung cells anticipates the claimed methods on the basis that the 14189 polypeptide of the instant claims is inherently in the human lung cells assayed by Meyers et al., thus contributing to the assayed kinase activity and these human lung cells and the polypeptides within the human lung cells are isolated prior to kinase activity assay. It is noted that isolation is interpreted as meaning the removal of a polypeptide or cell from the environment in which it normally exists. Thus claims 1, 2, 4, 6, 13-19, remain rejected for these reasons.

With respect to claims, 3, 7, 8, 9, 11, 12, 21-27 and 29-35 which were previously rejected, applicants have amended these claims to refer to the 14189 polypeptide as being "recombinant" (claim 3) or requiring "contacting a cell free assay mixture comprised of a 14189 polypeptide..." (claim 7).

In the case of claim 3 and its dependent claims, applicants reference to a recombinant 14189 polypeptide is acknowledged, but not found persuasive on the basis that a recombinant 14189 polypeptide and a non-recombinant 14189 polypeptide are considered to be the same polypeptide. Thus applicants reference to a "recombinant" polypeptide is not helpful in overcoming the previous rejection.

In the case of claim 7 and 9 and their dependents, in which applicants have refer to a step of "contacting a cell-free assay mixture", the methods taught by Meyers et al. involve detection of binding by "direct detecting of test compound/polypeptide binding; and b) detection of binding using a competition binding assay" each of which are performed through cell-free assay mixtures. Thus claims 7 and 9 and their dependents remain rejected for these reasons.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-9, 11-19, 21-27 and 29-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,656,698 B1. An obvious type double patenting rejection is appropriate where conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g.., *In re* Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re* Goodman, 11 F.3d

1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re* Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The rejection was stated in the previous office action as it applied to previous claims 1-4, 6-9, 11-19, 21-27 and 29-35. In response to this rejection applicants have amended claims 1, 2, 3, 5, 7, 9, 10 and 13-19 and traverse the rejection as it applies to the newly amended claims.

Applicants argue this rejection on the basis that the instantly pending claims are not obvious over claims 1-10 of Meyers et al. because none of the recited polypeptides or nucleic acid molecules is obvious over those in claims 1-10 of Meyers et al. To support this position applicants present the results of a BLAST alignment between Meyers SEQ ID NO: 2 and SEQ ID NO: 2 of the instant application.

Applicants amendment of the claims and applicants complete argument is acknowledged and has been carefully considered, however, is found non-persuasive for the reasons previously made of record and repeated herein. Applicants comparison of SEQ ID NO:2 of Meyers et al. and SEQ ID NO: 2 of the instant application is acknowledged, however, not considered as this is not the basis of the rejection. The claims of Meyers et al. and the instantly rejected claims are all drawn to methods not products and it is the methods of Meyers et al. that although they are not identical, they are not patentably distinct from each other because claims 1-10 of U.S. Patent No. 6,656,698 B1 drawn to a method for identifying a compound which modulates the activity of said kinase-like polypeptide comprising combining the polypeptide or a cell expressing the polypeptide such as a human lung cell with a test compound and

determining the effect of the test compound on the activity of the polypeptide using a kinase assay anticipates claims 1-4, 6-9, 11-19, 21-27 and 29-35 of the instant application for the reasons discussed above under the 102 rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat T. Nashed can be reached on 571-272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rgh
4/9/2008

/Richard G Hutson, Ph.D./
Primary Examiner, Art Unit 1652